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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/048,194

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Michael R. Emmert-Buck

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EXAMINER

SANG, HONG

ART UNIT

PAPER NUMBER

1643

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/048,194

Applicant(s)

EMMERT-BUCK, MICHAEL R.

Examiner

Hong Sang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44, 46-54 and 67-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-44, 50, 67-70 and 72 is/are allowed.
- 6) ☒ Claim(s) 46-49, 51-54 and 71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

RE: Emmer-Buck

1. Applicant's response filed on 6/20/2006 is acknowledged. Claims 1, 4, 5, 7, 9, 10, 11, 14, 18, 20, 21, 25, 34, 37, 43, 44, 46, 50, 68 and 69 are amended. New claims 70-72 are added.
2. Claims 1-44, 46-54 and 67-72 are pending and under examination.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Rejections Withdrawn

4. The rejections of claims 10, 25, 44, 50, 68 and 69 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of applicant's amendment to the claims.
5. The rejection of claims 1, 2, 42, and 67 under 35 102(b) as being anticipated by Imai et al. (US 5,057,438, issued 10/15/1991, IDS) is withdrawn in view of application's amendment to claim 1.
6. The rejection of claims 1-4, 10, 11, 14-18, 20, 21, 24-29, 32-42, and 67 under 35 U.S.C. 102(b) as being anticipated by Christian (EP 0 139 373 A1, IDS) is withdrawn in view of applicant's amendment to claim 1.

7. The rejection of claims 1-44, 50, and 67-69 under 35 U.S.C. 103(a) as being unpatentable over Christian (EP 0 139 373 A1, IDS) in view of Imai et al. (US 5,057,438, IDS), Okabe et al. (J. Histochem. Cytochem. 1993, 41(6):927-934), Olsen et al. (J. Immun. 1998, 220: 77-84, IDS), Manabe et al. (Anal. Biochem. 1984, 143: 39-45, IDS), Pappalardo et al. (Seminars in Radiation Oncology, 1998, 8(3): 217-223, and IDS), Huang et al. (Analytical Biochemistry, 268: 305-317, 1999) is withdrawn in view of applicant's amendment to claim 1.

8. The rejection of claims 1-6, 8-21, 24, 32-37, 40-42, 44, 46-54, 67 and 69 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 12-14, 16, 19, 21, 23-27, and 30-32 of U.S. Patent No. 6,602,661 in view of Christian (EP 0 139 373 A1, IDS) is withdrawn in view of applicant's persuasive arguments and further consideration.

Response to Arguments

9. The rejection of claims 46-49, 51-54 and new claim 71 under 35 U.S.C. 103(a) as being unpatentable over Christian (EP 0 139 373 A1, IDS) in view of Imai et al. (US 5,057,438, IDS), Okabe et al. (J. Histochem. Cytochem. 1993, 41(6): 927-934), Olsen et al. (J. Immun. 1998, 220: 77-84, IDS), Manabe et al. (Anal. Biochem. 1984, 143: 39-45, IDS), Pappalardo et al. (Seminars in Radiation Oncology, 1998, 8(3): 217-223, and IDS), Huang et al. (Analytical Biochemistry, 268: 305-317, 1999) is maintained.

The response states that neither Imai nor Christian teaches all the limitations of the amended claim 1 (see response page 13, last paragraph, line 3). The methods of Imai and Christian do not provide a two-dimensional pattern on the planar surface of individual membrane. These deficiencies of the base references are not made up for in any of the secondary references. Therefore, there is no motivation to combine these references.

Applicant's arguments have been carefully considered but are not found persuasive. As indicated in the previous office action mailed on 12/20/05 and discussed in the interview on 4/17/06, this rejection could be overcome if the claims are amended to include the limitation "a two-dimensional architecture of the biological specimen is preserved throughout the transfer". Since claims 46-49, 51, 51-54 and new claim 71 do not recite such limitation, and are not dependent from claim 1, the rejections are still deemed proper and maintained for the same reasons set forth in the previous office action.

Conclusion

10. Claims 1-44, 50, 67-70 and 72 are allowed. Claims 46-49, 51-54 and 71 are rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hong Sang whose telephone number is (571) 272 8145. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry R. Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hong Sang
Art Unit 1643
Aug. 20, 2006



LARRY R. HELMS, PH.D.
SUPERVISORY PATENT EXAMINER